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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,042	02/25/2002	Nicholas Luke Bennett	007051.P011	7776
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EXAMINER				
SHAH, MILAP				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/857,042

Applicant(s)

BENNETT ET AL.

Examiner

MILAP SHAH

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-74, 77-80, 84, 87-95, 97, 103 and 106-114 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 72-74, 77-80, 84, 87-95, 97, 103 and 106-114 is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This action is in response to the request for reconsideration filed after non-final office action received on April 27, 2010. The Examiner acknowledges that no claims were amended or canceled. Therefore, claims 72-74, 77-80, 84, 87-95, 97, 103, & 106-114 remain pending.

Response to Arguments

Applicant's arguments filed April 27, 2010 have been fully considered but they are not persuasive. Applicant argues that Ugawa fails to anticipate periodically displaying a visual character to communicate information on a display of a console, in response to a random event to a bet amount placed. The Examiner respectfully disagrees.

First, Applicant notes that paragraph 0033 and figure 26 fail to disclose the limitation as cited by the Examiner. The Examiner respectfully submits that a typographical error occurred in referencing the citation. Nonetheless, Ugawa teaches Applicant's claimed invention within a broadest reasonable interpretation. It should be noted that Applicant also bears the burden of considering a reference in its entirety, as rejections are based on rejections, where citations are merely representative of the teachings contained therein and are merely for the convenience of the Applicant. A rejection is based on a reference as a whole, versus specifically cited portions of a reference. Thus, in preparing any response to any official action, the Applicant always bears an equal responsibility to fully consider any applied reference in its entirety as potentially teaching all or part of the claimed invention.

The Applicant argues that the term "WC RND RCH" is a random number designed for actuation fluctuation, such that once the random number has been generated, WC RND RCH remains fixed. Regardless, the claimed invention is broad and appears to merely require a visual character (clearly shown in the figures of Ugawa), the visual character periodically displayed to communicate information, the

character appearing on the display (i.e. a character to communicate information is also clearly shown in the figures), the character having an association with a function of the gaming console, and wherein the appearance of the character is triggered by a random event related to the amount of a bet placed. As indicated in previous prosecution of the instant application, in a broadest reasonable interpretation, Ugawa explicitly discloses a random occurrence of a “great success” outcome, such as a high value payout (paragraph 0014, where great success is determined by WC RND L, WC RND C, and WC RND R, which are random numbers generated by the gaming console; see also paragraph 0020), where upon determining the gaming machine is to be in a “great success” outcome mode, the visual character is displayed to communicate great success information, wherein this character is thereby associated with a function of the gaming console (i.e. associated with a great success outcome) and appears randomly based on a random event (i.e. the randomness of receiving a great success based on the random number generator) and is at least based on the amount of bet placed, in a broadest reasonable interpretation, as the gaming machine cannot operate without a bet being placed, such as a minimum wager. Thus, the randomness of the visual character can only occur after receiving at least a minimum bet required to be eligible for the great success outcome in the situation discussed above.

For at least these reasons, Ugawa is considered to anticipate at least claims 72-74, 77-79, 103, 106, & 107 as set forth below. The rejection(s) of the pending claims from the previous office action are maintained herein and represented below for Applicant's convenience. The Examiner has fixed the typographical error with regards to the specific citations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 72-74, 77-79, 103, 106, & 107 are rejected under 35 U.S.C. 102(b) as being anticipated by Ugawa (Japanese Publication No. 09-047550, published February 18, 1997). A machine translation to English of the abstract, claims and detailed description was provided in a previous office action.

Claim 72 & 73: Ugawa generally discloses the same invention including a gaming machine with a display and a game controller as is known in the art (see at least figures 1-4), where the game controller is arranged to play a game wherein one or more random events are caused to be displayed on the display and, if a predetermined winning event or combination of events results, the machine awards a prize, the console being characterized in that an animated character is periodically displayed to communicate information to the player, the character being arranged to appear superimposed over any game screen currently displayed at the time the character is displayed, the character appearing to at least control the dispensing of a prize (abstract, figures 36-42, and paragraphs 0033-0042). Generally, Ugawa discloses the character appears to provide information as to the dispensing or controlling of a prize, such that the predictive information is associated with a prize winning jackpot or outcome that'll eventually hit in subsequent games. Ugawa discloses the character appears at least to delivery predictive information regarding a big hit or big jackpot, such that the occurrence of the character appears to be independent of the specific outcome of the game being played, but rather the character appears randomly based on a trigger signal, such as in a situation where the outcome is a "great success" high value payout (paragraphs 0005, 0014, and 0020, where it appears that a random event occurs via random numbers, such as the determination of a great success outcome, and if such an outcome is to be achieved, a visual character as clearly depicted in the figures of Ugawa, is displayed to communicate great success

information). The triggering of the appearance of the character is clearly associated with a function or feature selected from a plurality of functions or features associated with the game console (i.e. the triggering is random and the triggering is commensurate with a specific outcome within the game). Moreover, the visual appearance of the character is periodic and random based on the great success state, where such periodic and random appearance of the character is also implicitly related to the amount of a bet placed on the gaming machine, such as a minimum bet that must be placed in the gaming machine to activate said gaming machine to provide the player with the game play and to receive the random appearance of the visual character as discussed above.

Claim 74: Ugawa discloses various “features” such as the predetermined predictive information to be displayed by the character, where the character is able to show various statements as disclosed by paragraphs 0033-0034, such that the trigger signal must include a portion to indicate which of the messages will be displayed after initiation of that particular “feature”. These separate features each have a separate probability of occurring as discussed by Ugawa all throughout the disclosure of the invention.

Claims 77-79: Ugawa discloses another trigger symbol associated with the primary game being the pachinko game (figure 1), where the ball lands in a certain area triggering the “bonus” game of the video display; thus, it’s clear the bonus or secondary game starts after the completion of the primary game, simply because when the ball lands in the area to initiate the trigger signal, that primary game has been completed (paragraph 0023). It is understood in the art that bonus games are automatically commenced, thus, the player would not be given the opportunity to bet again until completion of the bonus round. Regarding claim 79, the first function associated with the character appears to be the primary game play with the predictive information being displayed and

second function appears to be the secondary or bonus game play, where the primary and secondary game play resulting from the first bet are completed prior to a second bet can be placed, such as a second bet on a second primary game.

Claim 103: Ugawa clearly discloses the information is displayed at least in symbols and/or text (figures 36-42).

Claim 106: As discussed above with respect to claim 72, the character is based upon at least a random trigger event.

Claim 107: Ugawa discloses the character is triggered at least for the purpose of providing predictive information in accordance with a probability of hitting a bonus award (see entire disclosure referencing “probabilities” throughout).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 80, 84, 87-95, 97, & 108-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa, as applied to claims 72-74, 77-79, 103, 106, & 107, where applicable.

Claims 80, 84, 87-95, & 97: Ugawa discloses the invention substantially as claimed except for explicitly disclosing:

the character indicating a reel to be indicated as a wild, where the character indicates such by climbing into the foreground of that reel (claims 87-88);

the character offering a selection between two or more objects, such as the animated character holding two objects, the objects may be money or box representations, or bonus features, the player choosing one of the objects (claims 89-92);

the character awarding free games, a multiplier, and/or other prizes (claims 93 & 94); and

the character causing reels to spin in a primary and game and awards bonus games, wherein the primary game is a slot game versus a pachinko game (obvious variant), and the bonus game as in Ugawa is a slot game having associated awards (claims 80, 84, 95, & 97).

Regardless of these deficiencies, they would have been an obvious matter of design choice to those of ordinary skill at the time of the invention. The Applicant has not stated that such specific aesthetic functions of the character provide any particular unexpected result or solve any stated problem, and it appears the gaming machine would perform equally well with the character simply performing the tasks as disclosed by Ugawa. For example, the primary game being a slot game versus a pachinko game is considered a mere design consideration, as it would require only routine skill in the art. Alternatively, or in conjunction with the design choices, these features of the character prove to be merely functional language, such that within an apparatus claim, the Examiner must show an equivalent structure to properly reject the claims and any functional language is not given the patentable weight that it would be given if written in a method claim. MPEP 2114 recites that “while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function”. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Federal Circuit, 1997). MPEP 2114 also recites “A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations

of the claim". *Ex parte Masbam*, 2 USPQ2d 1647 (Board of Patent Appeals & Interferences, 1987). Therefore, the Examiner submits that the limitations discussed above would have been obvious design choices as to the function of the disclosed visual character to those of ordinary skill in the art at the time of the invention. These obvious design elements for the character's functionality would have produced predictable results in accordance with the specific design implemented. It appears that no unexpected results arise from the functionality of the character within the indicated claims. Therefore, for at least the reasons given, it would have been *prima facie* obvious to modify Ugawa to obtain the invention as specified in claims 80, 84, 87-95, & 97. One of ordinary skill in the art would be motivated to produce new design and effects for the simple reason of providing new and exciting games for casino patrons in an industry where game machines are constantly being changed, upgraded, and re-designed to be appealing to the casino patrons, who are always looking for a new game to play. As such, new game designs appear to increase at least gaming revenue and casino appeal, which seems to be the underlying goal for gaming designers, thus, a skilled designer would be motivated to provide a plethora of special effects using the visual character.

Claims 108-114: Ugawa discloses the invention substantially as claimed except for explicitly disclosing that the character is arranged to appear on a bank of consoles in a coordinated manner, such as progressing/walking from one machine to another, where it may appear on one machine before it moves to the next or appear simultaneously on at least two machines such as when the character is in between two machines, or the like. Regardless of these deficiencies, it would have been notoriously well known in the art and would have required a mere design consideration. First, the Examiner submits that moving animations from one display to another is notoriously well known in the computer and gaming arts, such as a dual-monitor setup for a computer, where

windows are transferable between two separate displays, or such as scrolling message displays in a bank of gaming machines, where a message essentially leaps from one machine's display to the next. These concepts are well known techniques in the art for moving animations between displays. Second, the Examiner submits that connecting multiple gaming machines to form a bank of gaming machines is also well known in the art. Accordingly, the Examiner submits that it would have required only routine skill in the art along with obvious design considerations to implement the visual character across a bank of gaming machines. The remaining functional language directed to what exactly the character will do, as discussed above, is a design consideration relating to ornamentation. The combination of known elements or techniques including multiple gaming machines connectable into a bank of machines, an animated visual character, and moving graphics between multiple separate displays as taught by the art of record and known techniques to those skilled in the art, would have produced expected results for a skilled artisan, yielding an invention comprising an animated visual character inclusive in a bank of gaming machines in which the animated character is able to move across multiple displays for purposes of interactive gaming. Therefore, it would have been *prima facie* obvious to modify Ugawa with known elements and techniques to obtain the invention as specified in claims 108-114. As evidentiary references for those elements considered well known in the art, the Examiner submits, U.S. Patent No. 5,655,961 to Acres et al. disclosing networked gaming (i.e. banks of gaming machines). The concept behind dual-monitors or animation between separate displays has been well known in the computer arts for many years; thus, it appears unnecessary to provide a specific reference.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MILAP SHAH whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/MBS/

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714